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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,772	07/28/2006	Stefan Kuchenhoff	2004P01227WOUS	9890
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BELL, BOYD & LLOYD, LLP P.O. BOX 1135 CHICAGO, IL 60690			EXAMINER JAMA, ISAAK R	
			ART UNIT 4163	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,772	<b>Applicant(s)</b> KUCHENHOFF ET AL.	
	<b>Examiner</b> ISAAK JAMA	<b>Art Unit</b> 4163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/28/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application publication number 2003/0069934 (Garcia-Martin et al.).

1. Regarding claim 10, Garcia-Martin teaches a registration device which registers the status of a subscriber in a network, connected to a distribution device (abstract, Figure 3, # 4), comprising: an interface connected to the distribution device (abstract, Figures 1 & 3, IM&P server and # 4 respectively) for distribution of a short message to an IP-compatible terminal (Figure 4, # 4), wherein the interface responds to the request of the distribution device for the status of the network access of the subscriber (Page 3, paragraph 0049).

2. Regarding claim 12, Garcia-Martin teaches a registration device wherein the message is a short message containing text (Page 1, paragraph 0013).

3. Regarding claim 13, Garcia-Martin teaches a registration device according to the message is a multimedia message containing images or video or both (Page 6, claim 5).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-9 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent applications Publication Number 2003/0069934 (Garcia-Martin et al.) in view of U.S. Patent application Publication Number 2003/0229722 (Beyda)

6. Regarding claim 6, Garcia-Martin teaches a distribution device for distributing short messages to an IP-compatible terminal (Figure 1, instant messaging and presence (IM&P) server) comprising: a receiving apparatus, which receives a short message to be sent to a subscriber (Figure 1, IM&P server; page paragraphs 0002 & 0003); an interrogation device (Figure 3, # 4, instant messaging and present agent (IMPA); page 2, paragraph 0045) in communication with the receiving apparatus (Figure 3, # 6, IM&P server) which, after the arrival of the short message for the subscriber, asks a registration device for the status of the subscriber whether the subscriber is online; and a control device, which evaluates the interrogation result and forwards the short message to the subscriber ( Figure 3, page 3, paragraph 0049). But Garcia-Martin fails to specifically teach that the message is buffered for sending at a later time. Beyda teaches a method and apparatus for governing processing of an instant message, for example, a user may want any instant message received from friends to be stored for later retrieval or reading (Page 3, paragraph 0035). Therefore, it would have been

obvious to a person of ordinary skill in the art at the time the invention was made to include the message storing option of Beyda in the communication method of Garcia-Martin in order to make the message available to the receiving entity for later processing.

7. Regarding claim 7, Garcia-Martin teaches a distribution device wherein the control device forwards the short message to the subscriber over an IP network if the result of the interrogation device reveals that the subscriber is online (Page 1, paragraph 0003).

8. Regarding claim 8, Beyda further teaches a distribution device wherein the control device buffers the short message for the subscriber if the interrogation device reveals through the registration device that the subscriber is not online and has no access to a circuit switched network, the control device then submits a new request to the registration device through the interrogation device at regular intervals and forwards the short message to the subscriber as soon as the interrogation device reveals that the subscriber is now online (column 4, paragraph 0037). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message storing option of Beyda in the communication method of Garcia-Martin for the reasons given above.

9. Regarding claim 9, Beyda teaches a distribution device wherein the control device forwards the short message to the subscriber via a circuit switched network if said interrogation reveals that the subscriber is not online (column 3, paragraph 0036; i.e. the receiver may want the instant message changed via a text-to-speech converter

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and sent to a telephone number which may be associated with a telephone or a voice-mail box; telephones are associated with a public switched telephone network which is a switched network). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message storing option of Beyda in the communication method of Garcia-Martin in order to make the message available to the receiving entity via other networks.

3. Claims 11, 14, and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia-Martin in view of U.S. Patent Application publication number 2003/0226143 (Michael et al.).

10. Regarding claim 11, Garcia-Martin has been discussed above, what Garcia-Martin fails to specifically teach is that the subscriber is connected to the system via a set top box communication device generally utilized for media viewing. Michael teaches a method and system for conveying SMS messages via a TV communication infrastructure for receipt by a TV set-top box (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message delivery option of Michael in the communication method of Garcia-Martin in order to make messages accessible to a user via television interactive systems.

11. Regarding claim 14, Garcia-Martin teaches a system for ensuring that short messages are not lost in a communication system and allowing the receiving of a short text message to a subscriber (Page 5, paragraphs 0108 & 0109; i.e. when the registration agent (RA) receives a session initiation protocol invite (SIP INVITE), the RA

detects that a manual dial-up connection is needed, it does not forward the invitation at this time) comprising: a registration device that registers whether the subscriber is on-line (page 3, paragraph 0047); and a distribution center that communicates with the registration device when a message is being received for the subscriber to determine if the subscriber is on-line and if the subscriber is on-line then the message is send to the subscriber through an IP network (page 3, paragraph 0049). But Garcia-Martin fails to teach that the subscriber is online via a set-top box. Michael teaches a method and system for delivering an SMS messages to a set-top box connected to a cable television (CATV) communication infrastructure (Figure 6, page 4, paragraph 0061). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message delivery option of Michael in the communication method of Garcia-Martin in order to make messages accessible to a user via television interactive systems.

12. Regarding claim 16, Garcia-Martin teaches a system wherein the distribution center a regular intervals communicates with the registration device to determine if the subscriber is on-line in order to send the message to the subscriber via the IP network when the subscriber is on-line (Figure 3, paragraph 0047)

13. Regarding claim 17, Garcia-Martin teaches a system wherein the distribution center further comprises: a receiving apparatus that receives a message to be sent to the subscriber; and an interrogation device for communicating with the registration device to determine whether the subscriber is online or not (Figure 3, # 4 and # 6; paragraph 00470).

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14. Regarding claim 18, Garcia-Martin teaches a system wherein the distribution center through the registration device receives an IP address for the subscriber and sends the message via a packet switched IP network to the subscriber (Page 4, paragraph 0076).

15. Regarding claim 19, Michael further teaches a system wherein the subscriber is connected to the system via a set top box communication device generally utilized for media viewing (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message delivery option of Beyda in the communication method of Garcia-Martin in order to make the message available to the receiving entity via a different media such as CATV.

16. Regarding claim 20, Garcia-Martin teaches a system according to claim 14, wherein the message is a short message containing text (Page 1, paragraph 0013).

17. Regarding claim 21, Garcia-Martin teaches a system the message is a multimedia message containing images or video or both (Page 6, claim 5).

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia-Martin and Michael as applied to claim 14 above in further view of U.S. Patent Application Publication Number 2003/0229722 (Beyda et al.).

18. Regarding claim 15, Garcia-Martin and Michael have been discussed above. What neither Garcia-Martin nor Michael teaches is a system wherein the distribution center if through the registration device determines the subscriber is not on-line then the distribution center buffers the short message until the subscriber is on-line. Beyda teaches a method and apparatus for governing processing of an instant message, for



example, a user may want any instant message received from friends to be stored for later retrieval or reading (Page 3, paragraph 0035). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the message storing option of Beyda in the communication method of Garcia-Martin in order to make the message available to the receiving entity for later processing.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Number 7,263,178 (Brothers et al.) teaches an automated communication assistant. U.S. Patent Number 7,139,797 (Yoakum et al.) teaches a presence information based on media activity. U.S. Patent Number 6,985,924 (Schwartz et al.) teaches a system and method for facilitating mediated communications. U.S. Patent Publication Number 2004/0215723 (Chadha) teaches a method and apparatus for facilitating online presence based actions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ISAAK JAMA whose telephone number is (571)270-5887. The examiner can normally be reached on 7:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Robinson can be reached on (571) 272-2319. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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/IRJ/

/Mark A. Robinson/

Supervisory Patent Examiner, Art Unit 4163